

ATTACHMENT TO PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant believes errors exist in the final rejection and respectfully requests a review. More specifically, Applicant believes that limitations in the pending claims are clearly not met by the cited reference.

Claims 1-8 are pending. All pending claims relate to methods for providing a product design software tool which allows a user to create an electronic product design, and which automatically incorporates into the design an advertisement not provided by the user, and which offers the user the option of removing the advertisement. This method is particularly advantageous to an advertiser if the removal of the advertisement is performed upon payment of a fee by the user of the electronic product design software tool.

The Examiner has rejected Claims 1-8 under 35 U.S.C. 102(e) as being anticipated by Ryan (US 6,173,274), which discloses a production mail system 15 (e.g., a Pitney Bowes postage meter) for producing a mailpiece including an inserter system for feeding a document in a path of travel and into an envelope 20. The document includes a control code printed thereon. The inserter includes a scanner located adjacent the path of travel for reading the control code on the document and a printer for printing a selected message on the envelope corresponding to the control code. (Ryan, Abstract) The control codes are used to target recipients in particular industries with relevant advertisement messages. (Ryan, col. 13, lines 45-50). A data processing system 80 includes an advertisements database 806 (Ryan, col. 8, lines 31-37) which provides a number of advertisement messages offered to the user of the meter which, if selected and printed on an envelope inserted into the postage meter, will result in a subsidy or invoice credit to the owner of the postage meter. (Ryan, col. 10, col. 6-9).

Ryan 1 does not teach or suggest "providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design" as

recited in Applicant's Claim 1. Ryan discloses a postage meter which is pre-configured to print postal indicia 30 (e.g., meter serial number 32, date 34, postal value 38) and may optionally print one or more pre-configured graphics provided by 3rd party advertisers. The postage meter cannot be equated with a "product design software tool" because it is not a software tool; rather, it is a physical tool and is not itself implemented in software. Further, the postage meter includes no means for allowing the user to create an electronic product design. First, there is no user interface which allows the user to examine and alter a design prior to printing the envelope; and second, the content to be printed on the envelope is not created by the user – rather, it is pre-programmed to print pre-configured postal indicia and advertisements that the user did not create. Finally, the envelope printed on by the postage meter itself also cannot be considered an electronic product design because it is the actual object and not the design of an object. Accordingly, Ryan does not meet the limitation "providing one or more product design software tools, the tools being adapted to (a) allow a user to create an electronic product design".

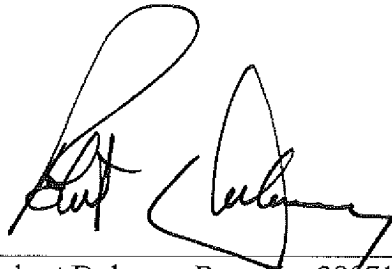
Applicant's Claim 1 specifically recites "the tools being adapted to ... (b) incorporate into the design an advertisement not provided by the user". Thus, Claim 1 requires that the advertisement is incorporated into the user's design by default. Ryan never requires that any advertisement is printed on an envelope. The decision of whether or not to select an ad from a number of possible ads for printing is entirely under the user's control. Ryan must actually provide incentive to get the user to opt to print the ad by providing a subsidy on the postage or meter invoice in exchange for printing the ad. Thus, Ryan actually teaches away from requiring the postage meter to "incorporate into the design an advertisement not provided by the user."

Applicant's Claim 1 also specifically recites "offering the user the option of removing the advertisement". As described above, Claim 1 requires that the advertisement is incorporated into the user's design by default. Only *after* incorporation of the advertisement into the user's design is the user presented with the option of removing the non-user ad. Ryan's system does not allow this. Ryan's system requires a user to actively select a particular advertisement from a database of possible subsidized

advertisements for printing on the envelope in order to take advantage of a subsidy associated with the selected ad. Thus, Ryan's users are subsidized (or credited on their postage meter invoices) to print an advertisement, whereas users of the Applicant's claimed method must actively opt (for example, by paying a surcharge) to remove a non-user advertisement from their user design.

Although Ryan's system does include an indicator 804b which allows the user of the postage meter to bypass third-party advertisement altogether (Ryan, Col. 9, lines 13-16), when the "bypass" setting is turned on, then no advertisements are first incorporated into the design prior to presenting the user the option of removing them. The ordering is important because, by Applicant requiring the advertisement to be first presented to the user through incorporation of the ad into the user's design and only then providing the user with the option of removing it, the advertiser is afforded the benefit of getting the ad in front of the user regardless of whether the user opts to include it or remove it. Ryan clearly teaches away from this by describing the opposite process, namely, providing a set of possible ads and then allowing the user to opt to include the ad for a subsidy. Furthermore, by requiring the user to pay a fee to remove the ad, as claimed in Applicant's Claim 3, the user must actively decide to pay more to remove the ad rather than passively deciding not to take advantage of a subsidy as in Ryan.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert Dulaney", written over a horizontal line.

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